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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,214	03/22/2001	David C. Paul	8932-342	2300
7590	03/06/2006			
JONES DAY 222 East 41st Street New York, NY 10017-6702			EXAMINER CHATTOPADHYAY, URMI	
			ART UNIT	PAPER NUMBER
			3738	
DATE MAILED: 03/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,214

Applicant(s)

PAUL ET AL.

Examiner

Urmi Chattopadhyay

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-21 and 23 is/are allowed.
- 6) ☒ Claim(s) 7-15, 22 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The amendment filed July 7, 2005 and the response to the notice of non-compliant amendment filed September 21, 2005 have been entered. All pending claims 7-26 are being considered for further examination on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7-15 and 24-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a bone fusion implant with a substantially enclosed hollow region formed *from* at least two concentric hollow cylinders of bone fragments, does not reasonably provide enablement for a bone fusion implant with a substantially enclosed hollow region formed *between* at least two concentric hollow cylinders of bone fragments, as required by independent claim 7. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. As shown in Figures 7B and 7C, there is no enclosed hollow region *between* the concentric hollow cylinders because ridge 1048 of a first component is configured to be press fit into the ridge 1049 of a second component. See page 23, lines 2-3 of the specification. The substantially enclosed hollow region of the hollow body is actually formed from the vacant centers of the concentric cylinders. The examiner strongly suggests changing

“between” on line 3 of claim 7 to either --from-- or --by--. Claim 7 has been interpreted for examination purposes with this change in effect. Upon making this change formally through an amendment, claim 7 will be allowable.

Claims 22, 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 7 is drawn only to the embodiment shown in Figures 7A-7C, and claim 16 is drawn only to the embodiments shown in either Figures 7A-7C or Figure 17. Claims 22 and 26, which are dependent on claims 16 and 7, respectively, further require the implant to comprise a region sized to receive a surgical instrument for facilitating implantation of the implant. This limitation is drawn to the embodiments shown in Figures 20-24 and 28, wherein a channel 1520 or threaded hole 1524 is provided on implant 1510 in order to receive a surgical instrument such as an inserter for implantation of the implant. See pages 27-28, lines 30-2. Because the specification does not disclose the embodiments shown in Figures 7A-7C and Figure 17 as comprising a region sized to receive a surgical instrument for facilitating implantation of the implant, and these claims were introduced in amendments after the filing date of the application, they are considered to contain new matter. The examiner strongly suggests canceling claims 22 and 26. Along the same lines, claim 25 is also considered to contain new matter because the embodiment shown in Figures 7A-7C does not comprise an outer surface with a wedge-shaped profile. This limitation is drawn to other patentably distinct embodiments; therefore, claim 25 should be canceled.

Allowable Subject Matter

Claims 16-21 and 23 are allowed.

Claims 7-15 and 24 would be allowed if claim 7 were amended as suggested above (change "between" to --from-- or --by--).

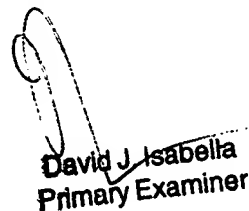
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urmi Chattopadhyay whose telephone number is (571) 272-4748. The examiner can normally be reached Monday through Thursday and every other Friday from 9:00am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached at (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Urmi Chattopadhyay
Art Unit 3738



David J. Isabella
Primary Examiner